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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/331,959	09/28/1999	RAYMOND DUBOUIS	022701-831	2312
21839	7590	11/28/2006		
BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			EXAMINER MOORE, MARGARET G	
			ART UNIT 1712	PAPER NUMBER

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/331,959

Applicant(s)

DUBOUIS, RAYMOND

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 35, 40 to 47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 29, 31 to 33, 40 to 47 is/are rejected.
- 7) ☒ Claim(s) 30 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1 to 21, 26, 40 and 42 to 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takita et al.

This rejection is based on the rationale noted in previous office actions. In an effort to distinguish the claims from the prior art applicants have amended the claim to include the language "consisting of". This excludes the azo compounds that are used in Takita et al.

Please note MPEP 2144.04 II which indicates that the omission of an element and its function is obvious if the function is not desired. In the teachings of Takita et al., if one did not desire the improved flammability, it would have been obvious to remove the azo compound. From the section of Takita et al. cited on the bottom of page 24 of applicants' response, it is clear that the azo compound *improves* flammability, not that it is necessary for flammability. See for instance column 1, line 12, which discloses that platinum compounds are known to make silicone rubbers nonflammable. On the other hand, the azo compounds in Takita et al. decompose to a compound that has a degree of toxicity (bottom of column 3). While the toxicity is not as high as it is when other azo compounds are used, the skilled artisan would have been motivated to remove this compound in an effort to decrease toxicity.

With regard to the comparative example that shows complete combustion, the Examiner notes that this is only one test of flammability. Something that does not show flammability in one test does not mean that the results will be the same for all tests. For instance, this reference measures flammability differently than applicants do in their specification (patentees measure a 1 mm thick sheet while page 28 of the specification measures a 2 mm thick sheet having a specific size). Also, Takita et al. measure combustion time while applicants measure extinction time.

Thus while one would not expect the composition to have the same degree of non-flammability as an azo containing composition, one would have a reasonable expectation of success in obtaining a silicone composition having some degree of non-

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flammability without an azo compound and having the added advantage of decreased toxicity.

On the other hand, note the rationale in paragraph 6 of the previous office action regarding the fact that an obvious composition does not become patentable simply because it is described as somewhat inferior to some other product for the same use. Even though the composition in comparative example 1 is inferior to the compositions described by Takita et al., this does not detract from the fact that the difference between a peroxide cured silicone rubber and a hydrosilylation cured silicone rubber would have been obvious given the totality of the teachings in Takita et al.

3. Claims 1 to 25, 27 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '644 in view of Matsushita.

This rejection is maintained for reasons of record. Again applicants have not provided any new arguments. The argument that is provided has been addressed in many previous office actions. See paragraph 3 of the previous office action.

4. Claims 28, 29, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cavezzan in view of JP '644.

Again, applicants' arguments are identical to those submitted previously and as such they will not be addressed again. Apparently applicants have inserted a ratio of FeO and Fe₂O₃ in an effort to overcome this rejection. This is not sufficient since JP '644, which is relied upon as teaching FeO and Fe₂O₃, teaches such a ratio.

It is unclear why applicants state in their summary of the interview of 8/9/06 that such a limitation renders the claims allowable, particularly since the Interview Summary Form supplied to applicants' representative states that no specific agreement was reached on a claim that would overcome the prior art.

In an effort to expedite prosecution, the Examiner notes that a specific ratio of d) to f) *could be* helpful in lending unobviousness to the claims. The Examiner stresses *could be* because it would depend on what, exactly, the ratio is and how broad it is. The Examiner thinks this might have been mentioned at the interview.

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5. Claims 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDermott et al. in view of JP '644.

Again, applicants' arguments are identical to those submitted previously and as such they will not be addressed again. Apparently applicants have inserted a ratio of FeO and Fe₂O₃ in an effort to overcome this rejection. This is not sufficient since JP '644, which is relied upon as teaching FeO and Fe₂O₃, teaches such a ratio.

It is unclear why applicants state in their summary of the interview of 8/9/06 that such a limitation renders the claims allowable, particularly since the Interview Summary Form supplied to applicants' representative states that no specific agreement was reached on a claim that would overcome the prior art.

In an effort to expedite prosecution, the Examiner notes that a specific ratio of d) to f) *could be* helpful in lending unobviousness to the claims. The Examiner stresses *could be* because it would depend on what, exactly, the ratio is and how broad it is. The Examiner thinks this might have been mentioned at the interview.

6. Claims 30 and 34 are objected to for reasons of record.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-

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272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
11/22/06